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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1949

No. 493

GRANAT BROS. (a corporation) and JOSEPH GRANAT,
Petitioners,

vs.

RALPH D. GOMEZ and WILLIAM HENDERSON, as individuals and co-partners doing business under the name of Gomez Manufacturing Company,
Respondents.

PETITION FOR WRIT OF CERTIORARI
to the United States Court of Appeals
for the Ninth Circuit
and
BRIEF IN SUPPORT THEREOF.

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PETITION FOR WRIT OF CERTIORARI
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To the Honorable Fred M. Vinson, Chief Justice of the United States, and to the Honorable Associate Justices of the Supreme Court of the United States:

Your petitioners, Granat Bros. and Joseph Granat, respectfully pray that a Writ of Certiorari issue to the Court of Appeals for the Ninth Circuit to review the decree of that Court holding invalid United States Letters Patent No. 2,059,228, which decree was entered on October 20, 1949. (R. 158.) Petition for rehearing was denied on November 28, 1949. (R. 159.) A certified transcript of the record in the case, including the proceedings in the Court of Appeals for the Ninth Circuit is furnished herewith in compliance with Rule 38 of the rules of this Court.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

This suit was brought by respondents against petitioners in the District Court for the Northern District of California to declare United States Letters Patent No. 2,059,228 owned by petitioners invalid. The single issue of the suit or action was the validity of that patent in that the respondents admitted infringement of the claims thereof. The District Court, after trial, held the patent valid, which holding of validity was reversed by the Court of Appeals for the Ninth Circuit. Opinion of the Court of Appeals appears at R. 150.

This petition seeks a review of that portion of the decree reversing the District Court and holding

United States Letters Patent No. 2,059,228 to be invalid. The ground of the holding of invalidity was that the device therein disclosed lacked patentable invention.

This holding of lack of invention raises a question of law, which is whether or not the fact that the individual elements of a new combination are all separately old, renders such new combination unpatentable as not being an "invention" and does not meet the requirements of the statute R. S. 4886, as amended, 35 U.S.C. § 31.

The Court of Appeals held that in order for a new combination to be patentable, some one element of the combination must be new and the result of invention or discovery. We quote from the opinion of the Court of Appeals (R. 156-157):

> "Granat did not invent nor discover the finger ring ensemble with interlocking relationship; neither did he invent nor discover the dovetail joint. He used the dovetail joint as a means of interlocking the two rings. * * *"
>
> "While the addition of a new element to an old invention may be patentable, such new element must be the result of invention or discovery as distinguished from the exercise of mechanical skill. * * *"

The Court of Appeals ignored the following findings of Fact of the District Court which were based upon substantial evidence in making its said holding:

> "7. That long prior to the defendant-cross-complainant's production of the ring ensemble or

set corresponding to that illustrated, described and claimed in the patent in suit No. 2,059,228, in the year 1934, there was a recognized need or want in the jewelry trade for a wedding and engagement ring set which would latch together to prevent relative rotation and axial movement between the rings when worn upon a finger." (R. 30.)

"9. That defendant-cross-plaintiff's production in 1934 of a ring ensemble or set corresponding to that illustrated, described and claimed in the patent in suit No. 2,059,228 satisfied the long felt want or need in the jewelry trade for a wedding and engagement ring set which would latch together and prevent relative rotation and axial movement between the rings when worn upon the finger." (R. 31.)

"12. That while the prior art offered in evidence discloses wedding and engagement rings which latch together, the rings illustrated, described and claimed in the patent in suit accomplish that result in a manner substantially different than the prior art and by means substantially different than the prior art and produce the old result in a novel and improved manner." (R. 32.)

"14. That the ring construction illustrated, described and claimed in the patent in suit No. 2,059,228 was not the result of mere mechanical skill but was the result of the inventive faculty." (R. 32.)

"15. That the patentee of the patent in suit by producing the ring ensemble or set illustrated, described and claimed in the patent in suit was the first in the art to provide a commercially

practical ring ensemble or set of a wedding ring and engagement ring capable of being latched together to prevent relative rotation and axial movement when worn upon the finger." (R. 32.)

"16. That although dovetail, tongue and groove or mortise and tenon devices were widely used in furniture making and the like and in the machinery business in general, the conception and practical application of the principle thereof to wedding and engagement ring ensembles to accomplish the result of preventing relative rotation and axial movement between such rings was the result of more than mere mechanical skill and was the result of invention." (R. 33.)

QUESTIONS PRESENTED.

The decree of the Court of Appeals for the Ninth Circuit raises the following question of law: Is the doctrine of the case of *Faulkner v. Gibbs,* 70 S. Ct. 25, "In the instant case, the patent has been sustained because of the fact of combination rather than the novelty of any particular element", the correct doctrine of interpretation of patentable combination under Revised Statute 4886, 35 U.S.C. § 31, or should that doctrine be limited as held by the Court of Appeals for the Ninth Circuit (R. 157) to a combination in which there is inserted or added a new element, which element must be the result of invention or discovery?

REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT OF CERTIORARI.

The discretionary power of the Court is invoked upon the following grounds:

(1) That the Court of Appeals for the Ninth Circuit, by ruling that in order to be a patentable combination, such combination must include a new element which in itself is the result of invention or discovery, has rendered a decision in direct conflict with a decision of this Court in *Faulkner v. Gibbs*, 70 S. Ct. 25.

(2) That the Court of Appeals for the Ninth Circuit, in ruling that in order to be a patentable combination, such combination must include a new element, which element is the result of invention or discovery, has imposed a new and undue restriction on what constitutes an invention under R. S. 4886, 35 U.S.C. § 31.

(3) That the issue involved is of great moment to the public in that there should be uniformity as to what constitutes a new and patentable combination under R. S. 4886, 35 U.S.C. § 31.

For these reasons it is respectfully submitted that this petition should be granted.

Dated, San Francisco, California,
December 14, 1949.

OSCAR A. MELLIN,
Attorney for Petitioners.

State of California,
City and County of San Francisco—ss.

Oscar A. Mellin, being duly sworn, deposes and says, that he is the attorney for the petitioners herein; that he prepared the foregoing petition and that the allegations thereof are true as he verily believes; that the foregoing petition for a Writ of Certiorari is not interposed for delay and that in his judgment the same is well founded.

OSCAR A. MELLIN.

Subscribed and sworn to before me this 15th day of December, 1949.

(Seal) HELEN KETTERBAUGH,
Notary Public in and for the City and County of San Francisco, State of California.

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Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the Court of Appeals for the Ninth Circuit in the instant case is reported at 83 U.S.P.Q. 197 (not as yet reported in Federal Reporter system) and is in the record filed herewith at R. 150. The

Findings of Fact and Conclusions of Law entered by the District Court are at R. 29. The District Court rendered no opinion.

JURISDICTION OF THIS COURT.

The grounds for jurisdiction are:

(1) The decree of the Court of Appeals for the Ninth Circuit was entered October 20, 1949. (R. 158.) Petition for Rehearing was denied November 28, 1949. (R. 159.)

(2) The decree was rendered in a suit under the patent statutes of the United States to determine the issues of validity and infringement of Letters Patent issued by virtue of R. S. 4886, 35 U.S.C. § 31.

(3) The statute under which the jurisdiction of this Court is invoked is Section 240(a) of the Judicial Code, 28 U.S.C. 347, as amended by the Act of February 13, 1925.

(4) The discretionary power of this Court to grant a Writ of Certiorari is also invoked on the ground that the Court of Appeals for the Ninth Circuit has decided an important question of federal law in a way probably in conflict with the applicable decisions of this Court.

(5) Case believed to sustain the jurisdiction is *Faulkner v. Gibbs,* 70 S. Ct. 25.

STATEMENT.

Supplementing the facts which are stated in the petition under the title "Summary Statement of the Matter Involved", we wish to set forth that the invention involved solved a long-standing problem of maintaining the wedding and engagement ring on the finger in matched relationship. That is to say, when diamonds are partly around the circle of the ring on each of the two rings, it is highly desirable that the two rings be maintained in correct register to give a proper appearance to the ensemble. This was a pressing problem of long standing, as found by the District Court. (Finding 9, R. 31.) This problem had existed for a considerable period and it was first commercially solved by the device of the patent in suit. (Finding 15, R. 32.) Immediately upon its solution by the patented device there was a widespread and heavy demand for ensembles embodying the new combination. (Finding 10, R. 31.)

Although the prior art did disclose rings that could be connected together, these rings failed to solve the problem properly. The new combination claimed and contended for in the patent was fitting the two rings with component parts of a dovetail tapered connection which enabled the connection between the rings without distorting the ornamentation or mountings thereof, and which made a firm but detachable connection between them. Such a dovetail type of connection in this art was new, although it was old in other arts, such as furniture making, heavy general machinery and the like. (Finding 16, R. 33.) The

District Court held that this combination was an invention, and we quote the language of the Court (Finding 16, R. 33):

> "That although dovetail, tongue and groove or mortise and tenon devices were widely used in furniture making and the like and in the machinery business in general, the conception and practical application of the principle thereof to wedding and engagement ring ensembles to accomplish the result of preventing relative rotation and axial movement between such rings was the result of more than mere mechanical skill and was the result of invention."

It is undisputed that all of the above findings are supported by substantial evidence, but the Court of Appeals for the Ninth Circuit, in reversing the District Court's holding of invention and validity, determined that because interlocking finger rings were old in the art and dovetail connections were old in other arts, that there would be no invention in making this new combination.

The Court of Appeals clearly ruled as a matter of law that if the component parts of a new combination are old and one of the elements is not the result of invention or discovery, then the combination is unpatentable as a matter of law. In support of this contention of the basis of the Court of Appeals ruling, we cite from the opinion as follows (R. 156-157):

> "Granat did not invent nor discover the finger ring ensemble with interlocking relationship; neither did he invent nor discover the dovetail

joint. He used the dovetail joint as a means of interlocking the two rings. * * *"

"While the addition of a new element to an old invention may be patentable, such new element must be the result of invention or discovery as distinguished from the exercise of mechanical skill. * * *"

STATUTES.

The statute involved in this case and which is necessary to be considered is as follows:

R. S. 4886, 35 U.S.C., § 31.

SPECIFICATION OF ERRORS.

The errors which the petitioners will urge if the Writ of Certiorari is allowed are that the Court of Appeals for the Ninth Circuit erred:

(1) in reversing the judgment of the District Court holding United States Letters Patent No. 2,059,228 to be valid;

(2) in failing to affirm the judgment of the District Court holding the patent No. 2,059,228 to be valid;

(3) in holding patent No. 2,059,228 to be invalid;

(4) in holding that to be a patentable invention for a combination, some one element thereof must be new and be the result of an invention and discovery;

(5) in failing to hold that a new combination may be patentable under R. S. 4886, despite the fact that all of the various elements thereof are separately old.

SUMMARY OF THE ARGUMENT.

The points of the following argument follow the reasons relied upon for the allowance of the Writ of Certiorari (page 6, supra).

ARGUMENT.

(1) THAT THE COURT OF APPEALS FOR THE NINTH CIRCUIT, BY RULING THAT IN ORDER TO BE A PATENTABLE COMBINATION, SUCH COMBINATION MUST INCLUDE A NEW ELEMENT WHICH IN ITSELF IS THE RESULT OF INVENTION OR DISCOVERY, HAS RENDERED A DECISION IN DIRECT CONFLICT WITH A DECISION OF THIS COURT IN FAULKNER v. GIBBS, 70 S. CT. 25.

(2) THAT THE COURT OF APPEALS FOR THE NINTH CIRCUIT, IN RULING THAT IN ORDER TO BE A PATENTABLE COMBINATION, SUCH COMBINATION MUST INCLUDE A NEW ELEMENT, WHICH ELEMENT IS THE RESULT OF INVENTION OR DISCOVERY, HAS IMPOSED A NEW AND UNDUE RESTRICTION ON WHAT CONSTITUTES AN INVENTION UNDER R.S. 4886, 35 U.S.C. §31.

In the case of *Faulkner v. Gibbs,* decided November 7, 1949, 70 S. Ct. 25, this Court reaffirmed the proposition that a patent for a combination of old elements may be valid and may include invention, and that there need not be novelty or invention embodied in any one particular element. On this point the Court stated:

> "In the instant case, the patent has been sustained because of the fact of combination rather than the novelty of any particular element."

This Court has previously ruled to the same effect; for example, *Cantrell v. Wallick,* 117 U. S. 689, 29 L.Ed. 1017, at 1018:

> "* * * So, a new combination of known devices, whereby the effectiveness of a machine is increased, may be the subject of a patent * * *."

It has long been a rule of this Court that from the fact that the elements of a device are claimed as a combination, as in the patent in suit, it may be presumed that each of the elements individually is old in the art.

> "The patent being for a combination, and no claim being made for a patent on any one of the elements, it is conclusively presumed either that they were old in the art or not patentable. Richards v. Chase Elevator Co., 159 U. S. 477, 486, 16 S. Ct. 53, 40 L.Ed. 225; City of St. Louis v. Prendergast, 29 F. (2d) 188 (C.C.A. 8)."
>
> *Harris v. Ladd,* 34 Fed. (2d) 761, at 762 (C.C.A. 8, 1929).

We here contend that the rule of the Court of Appeals, in reversing the District Court in the instant case, is in direct conflict with those decisions because in the instant case the Court of Appeals ruled that in order for a combination to be patentable, one of the elements thereof must not only be new and novel, but must embody in and of itself an invention and discovery.

We, therefore, urge that the Court of Appeals committed error and ruled in conflict with the above authorities of this Court, and consequently the petition for Writ of Certiorari should be granted.

(S) THAT THE ISSUE INVOLVED IS OF GREAT MOMENT TO THE PUBLIC IN THAT THERE SHOULD BE UNIFORMITY AS TO WHAT CONSTITUTES A NEW AND PATENTABLE COMBINATION UNDER R.S. 4886, 35 U.S.C. §31.

The decisions of this Court—*Faulkner v. Gibbs*, 70 S. Ct. 25, and *Cantrell v. Wallick*, 117 U. S. 689, 29 L.Ed. 1017—set forth a doctrine of long standing upon the patentability of a combination of old elements. The doctrine of the Court of Appeals in the instant case that one of the elements of a combination must be not only new but must in itself involve invention and discovery, is in direct conflict with the doctrine of the above cases of this Court, and in effect nullifies such doctrine, and if the doctrine of the Court of Appeals is to be sustained, the rights of the public as well as rights of the petitioners have been seriously impaired by the decision of the Court of Appeals for the Ninth Circuit.

CONCLUSION.

It is respectfully submitted that the question of law herein involved is of great importance and should be determined by this Court for the sake of uniformity.

It is further respectfully submitted and therefore petitioners respectfully pray that their petition for a writ of certiorari be granted.

Dated, San Francisco, California,
December 14, 1949.

Respectfully submitted,
OSCAR A. MELLIN,
Attorney for Petitioners.